

This Opinion is Not a
Precedent of the TTAB

Hearing: November 2, 2022

Mailed: September 26, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Benjamin & Brothers, LLC d/b/a Reservations.com

Serial No. 88396223
—

Amber N. Davis of Wolter Van Dyke Davis PLLC,
for Benjamin & Brothers, LLC d/b/a Reservations.com.

Shaila E. Lewis, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

—
Before Cataldo, Wolfson, and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Benjamin & Brothers, LLC d/b/a Reservations.com (“Applicant”) seeks registration on the Principal Register (in the alternative, on the Supplemental Register) of the designation RESERVATIONS.COM, in standard characters, for the following services:

“Travel agency services, namely, making reservation[s] for auto transportation; providing consultation related to making reservations for auto transportation, all of the foregoing services via internet and over the phone” in International Class 39; and

“Making hotel reservations for others via the internet and over the phone; providing personalized information about hotels and temporary accommodations for travel via the internet and over the phone; consultation

services related to making hotel reservations for others, provision of personalized information about hotels and temporary accommodations for travel; travel agency services, namely, making reservations for temporary lodging” in International Class 43.¹

The Examining Attorney has refused registration on two alternative grounds: (1) under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§ 1091(c) and 1127, on the ground that Applicant’s proposed mark is the generic name for the services identified in the application and therefore not registrable on either the Principal or the Supplemental Register; and (2) under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant’s proposed mark is merely descriptive of Applicant’s services and has not acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

Applicant asserts that it is entitled to registration on the Principal Register on the ground that RESERVATIONS.COM is suggestive or, in the alternative, is merely descriptive of the identified services but has acquired distinctiveness as a source identifier.² Further in the alternative, if its proposed mark is found to be merely descriptive with no acquired distinctiveness, Applicant requests registration on the Supplemental Register.

The appeal is fully briefed. An oral hearing was held pursuant to Applicant’s request. For the reasons explained, we reverse the refusal to register on the ground

¹ Application Serial No. 88396223; filed April 22, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming April 2014 as the date of first use anywhere and in commerce for both classes of services.

² Because the Trademark Act Section 2(f) claim is made in the alternative, Applicant has not conceded that its proposed mark lacks inherent distinctiveness. *See In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011).

that RESERVATIONS.COM is generic for Applicant's identified services, but we affirm the refusal to register on the Principal Register on the ground that RESERVATIONS.COM is merely descriptive of Applicant's services and has not acquired distinctiveness. As discussed in detail below, the application will proceed on the Supplemental Register.

I. Evidentiary Issues

Applicant attached to its brief portions of the file history for the involved application. This was unnecessary. In any Board proceeding, the contents of the involved application or registration file are automatically of record and readily available to the panel. *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *1, n.4 (TTAB 2020). In addition, as we have repeatedly advised, it is improper to attach evidence of record to a brief.

Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations directly to the prosecution history were provided.

In re Michalko, 110 USPQ2d 1949, 1950-51 (TTAB 2014).

The attachments to Applicant's brief will be given no consideration. Applicant and its counsel are cautioned against attaching evidence to briefs in future cases before the Board, lest the briefs be rejected. Trademark Rule 2.128(b), 37 C.F.R. § 2.128(b)

("[A]ny brief with attachments outside the stated requirements may not be considered by the Board.").

We also do not consider the links embedded in Applicant's brief as links are not sufficient to place evidence into the record and, even if they were, it is too late to introduce new evidence at the briefing stage. Trademark Rule 2.142(d); 37 C.F.R. § 2.142(d); *see also, e.g., In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided).

We consider only the record for the application from the Office's Trademark Status and Document Retrieval Database (TSDR) database. We remind Applicant that the proper way to cite to evidence in the record is to identify the document by date and name and the page(s) where the evidence appears in the TSDR database. Trademark Rule 2.142(b)(3), 37 C.F.R. § 2.142(b)(3); *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *1 (TTAB 2019) (proper way to cite evidence is "to refer to it by Office Action/Response date and TSDR page number").³

We further note that both Applicant and the Examining Attorney introduced multiple copies of evidence. The Board has long discouraged this practice. *Virtual Indep. Paralegals*, 2019 USPQ2d 111512, at *1. Submitting evidence more than once

³ In this decision, citations to the record refer to the USPTO Trademark Status and Document Retrieval (TSDR) system by page number in the downloadable .pdf format. Citations to the briefs refer to TTABVUE, the Board's online docket system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable.

does not increase its probative value and, instead, undermines the effective presentation of the issues involved in the case, hinders the Board's review of the record, and ultimately delays issuance of a final decision. *Id.* (“[M]ultiple submissions of the same evidence can cause confusion in reviewing the record and unnecessary delay in issuing a final decision. If evidence that purportedly is the same is presented more than once, the Board must compare all versions of the evidence to confirm that it is, in fact, identical. This is not an appropriate use of the Board's limited resources.”).

II. Genericness Refusal

A. Applicable Law

A generic term is “the name of a class of products or services” and “is ineligible for federal trademark registration.” *U.S. Patent & Trademark Office v. Booking.com B.V.*, 591 U.S. ___, 2020 USPQ2d 10729, at *2-3 (2020) (“*Booking.com*”); *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 329 (1985) (“Generic terms are not registrable[.]”); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (“A generic term ‘is the common descriptive name of a class of goods or services”); *In re Uman Diagnostics AB*, 2023 USPQ2d 191, at *3 (TTAB 2023) (generic name of a thing is “ultimate in descriptiveness” and “is not entitled to registration on either the Principal or Supplemental Register under any circumstances.”). “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term to be protected to refer to the genus of goods or services in question.” *Royal Crown*, 127 USPQ2d at 1045

(quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986))).

“Whether a particular term is generic is a question of fact.” *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *6 (TTAB 2021) (citing *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009)). “The Federal Circuit has set forth a two-step inquiry to determine whether a mark is generic: First, what is the genus (category or class) of goods or services at issue? Second, does the relevant public understand the term sought to be registered primarily to refer to that genus of goods or services?”⁴ *In re GJ & AM, LLC*, 2021 USPQ2d 617, at *4-5 (TTAB 2021) (citing *H. Marvin Ginn*, 228 USPQ at 530); *see also Booking.com*, 2020 USPQ2d 10729, at *5 (“[T]he relevant meaning of a term is its meaning to consumers”); *Uman Diagnostics*, 2023 USPQ2d 191, at *4.

Where, as here, the designation at issue is a compound term, the second step in the inquiry “trains on the term’s meaning as a whole, not its parts in isolation.” *Booking.com*, 2020 USPQ2d 10729, at *5; *see also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (“In considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness [or genericness] of the mark and its various

⁴ Applicant refers to these principles as the “three guiding principles” set out in *Booking.com* and argues that the Examining Attorney erroneously focused on the Federal Circuit’s two-step inquiry. Appeal Brief, 17 TTABVUE 8. *Booking.com*, however, did not disturb the two-step inquiry used by the Federal Circuit. Rather, the case emphasizes the longstanding principle that when, as here, the proposed mark is a compound term, the second inquiry requires consideration of whether the compound term, **as a whole**, is generic. *Booking.com*, 2020 USPQ2d 10729, at *5 (“[W]hether ‘Booking.com’ is generic turns on whether that term, taken as a whole, signifies to consumers the class of online hotel-reservation services.”).

components. . . . However, . . . the PTO must also determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness [or genericness] of the individual parts.”). “A compound of generic elements is generic if the combination yields no additional meaning to consumers capable of distinguishing the goods or services.” *Booking.com*, 2020 USPQ2d 10729, at *7 (emphasis omitted).

“The relevant public’s perception is the chief consideration in determining whether a term is generic.” *GJ & AM*, 2021 USPQ2d 617, at *5 (citing *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 114 USPQ2d at 1833); *see also Booking.com*, 2020 USPQ2d 10729, at *6 (“[W]hether a term is generic depends on its meaning to consumers.”). “Competent sources to show the relevant purchasing public’s understanding of [a proposed mark] include purchaser testimony, consumer surveys, dictionary definitions, trade journals, newspapers and other publications.” *In re Country Music Assoc., Inc.*, 100 USPQ2d 1824, 1828 (TTAB 2011) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) and *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)); *see also Booking.com*, 2020 USPQ2d 10729, at *7 n.6 (relevant evidence includes any “source of evidence bearing on how consumers perceive a term’s meaning.”).

Also relevant may be any use of the proposed mark by the applicant. *Consumer Prot. Firm*, 2021 USPQ2d 238, at *8 (“In assessing the primary significance of Applicant’s Proposed Marks to the relevant public, we may also consider Applicant’s

use thereof.”) (citing *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987)); *In re Empire Tech. Dev. LLC*, 123 USPQ2d 1544, 1549 (TTAB 2017) (“[T]he way an applicant uses an alleged mark (or a component term in a mark), or the goods or services in connection with which it uses the alleged mark, in promotional materials or packaging, is relevant to whether consumers will perceive the mark as an indicator of source or instead as descriptive or generic.”) (quoting *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1590 n.22 (TTAB 2014)). Evidence that an applicant is the first or the exclusive user of a term does not automatically mean a term is not generic where other relevant evidence shows that the public will understand the term to name the genus of goods or services. *See, e.g., In re Nordic Nats., Inc.*, 755 F.3d 1340, 111 USPQ2d 1495, 1498 (Fed. Cir. 2014); *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 161 USPQ 606, 609 (CCPA 1969). In addition, we may consider use of the proposed mark by an applicant’s competitors. *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995) (“[C]ompetitor use is evidence of genericness.”); *Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013) (citing generic use of proposed mark “footlong” by applicant and its competitors).

Any doubt regarding whether the relevant public perceives the applicant’s proposed mark as a generic name for the identified goods or services must be resolved in the applicant’s favor. *GJ & AM*, 2021 USPQ2d 617, at *33 (citing *In re Waverly, Inc.*, 27 USPQ2d 1620, 1624 (TTAB 1993)); *Country Music Assoc.*, 100 USPQ2d at 1827.

B. Genus of Services

With respect to the first part of the two-step inquiry, the Examining Attorney asserts that the services in the application aptly identify the genus of services.⁵ Applicant does not argue to the contrary. Based on the recitation of services as they are identified in the application, namely:

- Class 39: “Travel agency services, namely, making reservation[s] for auto transportation; providing consultation related to making reservations for auto transportation, all of the foregoing services via internet and over the phone” and
- Class 43: “Making hotel reservations for others via the internet and over the phone; providing personalized information about hotels and temporary accommodations for travel via the internet and over the phone; consultation services related to making hotel reservations for others, provision of personalized information about hotels and temporary accommodations for travel; travel agency services, namely, making reservations for temporary lodging.”

we agree that the genus of services is “travel reservation services for temporary accommodations and auto transportation.”

In considering the second part of the two-step inquiry, we must consider whether the relevant public understands RESERVATIONS.COM, as a whole, to refer to travel reservation services for temporary accommodations and auto transportation. *Booking.com*, 2020 USPQ2d 10729, at *5; *GJ & AM*, 2021 USPQ2d 617, at *29-30. Applicant does not dispute the Examining Attorney’s assertion that the relevant public comprises ordinary consumers of travel reservation services for temporary accommodations and auto transportation.

⁵ Examining Attorney’s Brief, 19 TTABVUE 5-6.

C. Evidence

The record includes the following evidence pertinent to the genericness refusal:

- Dictionary definitions for the component parts comprising the compound term

RESERVATIONS.COM:

Reservation (noun):⁶ “An arrangement by which accommodations are secured in advance, as in a hotel, restaurant or on an airplane”⁷; “an arrangement to have something (such as a hotel room) held for one’s use[.] also a promise, guarantee, or record of such engagement[.]”⁸

.com: “Abbreviation for company: used in some internet addresses that belong to companies or businesses”; and “used at the end of some Internet addresses belonging to businesses[.]”⁹

- Printouts from numerous websites demonstrating that third parties offering travel reservation services commonly use the word “reservation(s)” and phrases such as “make a reservation,” “manage reservation(s)” and “my reservation(s)” in offering such services.¹⁰

⁶ The plural word “reservations” in Applicant’s proposed mark is not materially different from the singular word “reservation.” See, e.g., *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (“[T]here is no material difference, in a trademark sense, between the singular and plural forms of the word ‘Zombie’[.]”); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (singular and plural of SWISS GRILL deemed “virtually identical”); *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (SHAPE and SHAPES deemed essentially the same mark).

⁷ July 4, 2019 Office Action, TSDR 6 (www.yourdictionary.com sourced from THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Edition).

⁸ February 3, 2020 Office Action, TSDR 104 (MERRIAM-WEBSTER DICTIONARY); see also *id.* at 108.

⁹ May 11, 2021 Office Action, TSDR 30 (CAMBRIDGE DICTIONARY).

¹⁰ May 11, 2021 Office Action, TSDR 9-14, 19-20, 26-29, 109-16; February 3, 2020 Office Action, TSDR 11-38, 42-48.

- Screenshots and printouts from Applicant’s website and social media pages as well as Google and Google Auction Marketplace showing use of the proposed mark.¹¹
- More than 10 third parties using domain names incorporating “reservation(s).com,” preceded by either a descriptive, geographical, or other term, for websites offering travel reservation services for temporary accommodations, including the domain names hotel-reservations.com, thehotelreservations.com, and worldwide-hotelreservations.com.¹²
- Printouts from third-party online forums and consumer review websites reflecting consumer perception of the proposed mark.¹³
- Several articles and websites discussing travel reservation services generally as well as the specific services offered by Applicant.¹⁴
- Applicant’s survey, conducted by Dr. Robert A. Peterson to determine consumer perception of the proposed mark RESERVATIONS.COM for “hotel

¹¹ See, e.g., August 11, 2021 Office Action Response, TSDR 23, 117-18, Second Chaddah Affidavit, ¶ 16 and Exhibit 7; May 11, 2021 Office Action, TSDR 99, 105; January 6, 2020 Office Action Response, TSDR 22, 87-88, Jonna Affidavit, ¶ 13 and Exhibit 7; April 22, 2019 Specimen, TSDR 5, 7.

¹² May 11, 2021 Office Action, TSDR 120, 124-27; see also *id.* at 7, 35-36, 89-98, 121-23, 128-31.

We have not considered the examples of third-party domain names incorporating “reservation(s).com” for services that fall outside the genus of the specific travel reservation services before us, e.g. flight reservation services.

¹³ October 18, 2021 Second Final Office Action, TSDR 6-17; May 11, 2021 Office Action, TSDR 37-40, 85-88; TSDR 37-40; October 30, 2020 Final Office Action, TSDR 80-92.

¹⁴ See, e.g., April 12, 2022 Denial of Request for Reconsideration, TSDR 5; February 3, 2020 Office Action, TSDR 59-60, 93-99, 101-03; January 6, 2020 Office Action Response at TSDR 51-53, 61, 64, 68, 71-85.

and rental car booking services.”¹⁵ Dr. Peterson asserts that “the conclusion to be drawn from the survey is straightforward. A majority of the target universe, 60 percent, perceives the term RESERVATIONS.COM to be a brand name not a common name. Thus, in my opinion, RESERVATIONS.COM is not a generic term.”¹⁶

- Affidavits from Applicant’s Chief Strategy Officer, Manoj Jonna, and an affidavit from one of its Officers, Mahesh Chaddah.¹⁷

D. Analysis

“A compound of generic elements is generic if the combination yields no additional meaning to consumers capable of distinguishing the goods or services.” *Booking.com*, 2020 USPQ2d 10729, at *7. “The U.S. Court of Appeals for the Federal Circuit more specifically states on this point: ‘where the [proposed] mark in its entirety has exactly the same meaning as the individual words, ... the [US]PTO has satisfied its evidentiary burden if ... it produces evidence ... that the separate words joined to form a compound ... have a meaning identical to the meaning common usage would ascribe to those words as a compound’” *In re Consumer Prot. Firm*, 2021 USPQ2d 238, at *16-17 (quoting *Princeton Vanguard*, 114 USPQ2d at 1831-32). “Thus, we may

¹⁵ August 11, 2021 Office Action Response, TSDR 129, Peterson Expert Report, ¶ 29.

¹⁶ August 11, 2021 Office Action Response, TSDR 131, Peterson Expert Report, ¶ 34.

¹⁷ The record includes 2 affidavits from Mr. Chaddah that are substantially identical but the August 10, 2021 affidavit (the “Second Chaddah Affidavit”) has updated figures regarding sales, advertising, page views and reservations. We cite only to the Second Chaddah Affidavit as it contains the most up-to-date information. In the affidavit, Mr. Chaddah identifies himself only as an “Officer” of Applicant. Neither Mr. Chaddah nor Applicant identify the specific title he holds at the company.

consider the understood meanings of portions of Applicant’s Proposed Word Mark as a step in the process towards our ultimate finding of whether the proposed mark, as a whole, is generic for Applicant’s services.” *Id.* at *17.

Not surprisingly, there is ample evidence in the record that the word “reservations,” alone, is generic for travel reservation services for temporary accommodations and auto transportation, namely:

- Applicant’s use of the word “reservations” (and the singular form “reservation”) in the identifications of services in its application;
- The dictionary definitions for the word “reservation”;¹⁸
- The “Customer Support” page on Applicant’s website providing consumers with “additional assistance with your existing hotel reservation” including a “My Reservation” feature to “Cancel your Reservation” and offering the following under “Knowledge Base”:¹⁹

“Where can I access my receipt for my reservation?”

“How do I cancel my reservation?”

“How do I modify my reservation?”

“If I change a hotel reservation, will I still get the same rate?”

“Will I be charged a night’s stay if I miss my reservation or arrive late?”

“Where can I access my receipt for my reservation?”

“If I cancel my reservation, when will I receive a refund?”

¹⁸ July 4, 2019 Office Action, TSDR 6 (www.yourdictionary.com sourced from THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Edition); February 3, 2020, TSDR 104 (MERRIAM-WEBSTER DICTIONARY); *see also id.* at 108.

¹⁹ April 22, 2019 Specimen, TSDR 5.

- Numerous third parties using the word “reservation(s)” to refer to hotel and car reservation services.²⁰ For example:

- (1) the Georgia Department of Natural Resources State Parks & Historic Sites offers “**Reservations** for Cabins, Camping Shelters & More” and has numerous references to its reservation services, e.g. use of the heading “**RESERVATIONS**” and “How Do I Make a **Reservation**?[:] ... Select your desired park from a map & click ‘**Make a Reservation**’....” (May 11, 2021 Office Action, TSDR 26-29); and
- (2) Enterprise: Allowing users to “Reserve a Rental Car”; “See how much it costs to rent a car for the day, a weekend or a full week by starting a **reservation** now.” (February 3, 2020 Office Action, TSDR 28-32).

With respect to the “.com” portion of the proposed mark, “the Supreme Court in *Booking.com* left undisturbed the circuit court’s finding that ‘.com does not itself have source-identifying significance when added to [a second-level domain] like booking.’” *GJ & AM*, 2021 USPQ2d 617, at *32 (quoting *Booking.com B.V. v. USPTO*, 915 F.3d 171, 185 (4th Cir. 2019), *aff’d*, *USPTO v. Booking.com B.V.*, 2020 USPQ2d 10729, at *2). Consistent with the dictionary definition, the “.com” portion of the compound term RESERVATIONS.COM is likely to be perceived as “an abbreviation for company” and part of an Internet address for a company.²¹

We must consider whether the combination of these two generic terms forming the proposed mark RESERVATIONS.COM “yields no additional meaning to

²⁰ May 11, 2021 Office Action, TSDR 9-14, 19-20, 26-29, 109-16; February 3, 2020 Office Action, TSDR 11-38, 42-48.

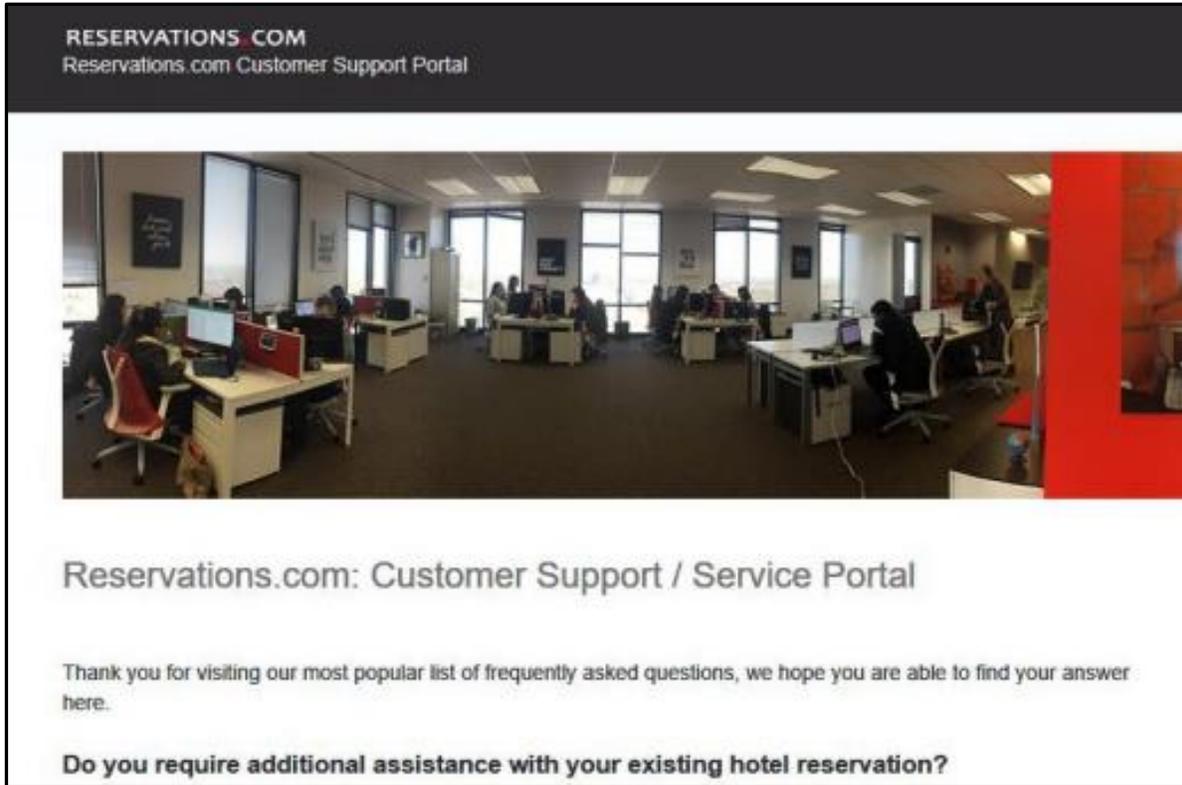
²¹ May 11, 2021 Office Action, TSDR 30 (CAMBRIDGE DICTIONARY).

consumers capable of distinguishing the ... services.” *Booking.com*, 2020 USPQ2d 10729, at *7. The genericness inquiry in a case involving a generic term and a top level domain such as .com is unique because “only one entity can occupy a particular Internet domain name at a time,” and therefore, a proposed mark consisting of “generic.com” might be capable of “convey[ing] to consumers a source-identifying characteristic: an association with a particular website.” *Id.* at *6.

The evidence that numerous competitors use domain names incorporating “reservation(s).com” to identify travel reservation services for hotel and auto transportation supports the Examining Attorney’s position that when the terms “reservations” and “.com” are combined, they retain their generic significance. This type of third-party use evidence may be probative of genericness. *See, e.g., In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (“Because websites operate under the term ‘mattress.com’ to provide mattresses, and they provide them online, the Board properly concluded that the relevant public understands the mark MATTRESS.COM to be no more than the sum of its constituent parts, *viz.*, an online provider of mattresses.”); *Hotels.com*, 91 USPQ2d at 1537 (Fed. Cir. 2009) (affirming refusal to register HOTELS.COM on genericness grounds explaining “the TTAB could reasonably have given controlling weight to the large number of similar usages of ‘hotels’ with a dot-com suffix” as well as other evidence); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1381 (Fed. Cir. 2007) (domain names incorporating proposed mark were “competent sources” on the issue of genericness and “provide[d] substantial evidence to support the board’s

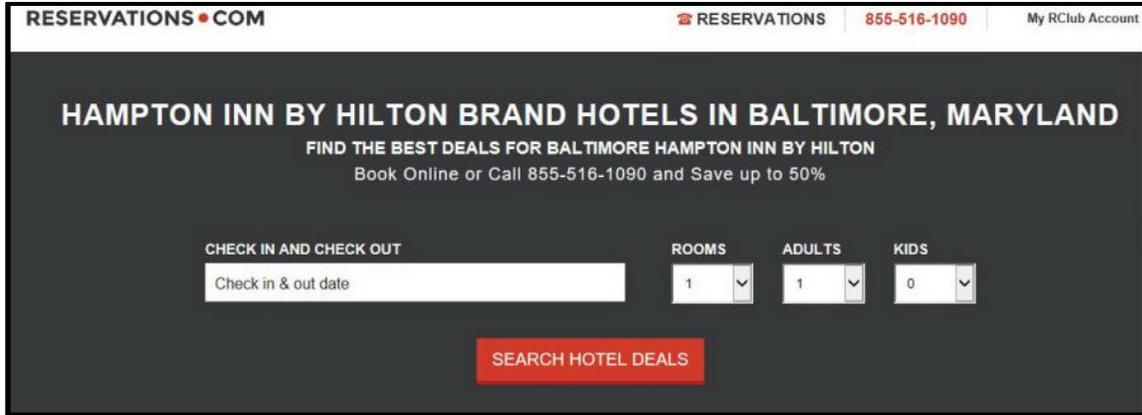
finding” that lawyers.com was generic for an “online interactive database featuring information exchange in the fields of law, legal news, and legal services”); *cf.* *Booking.com*, 915 F.3d at 182 (“district court did not err in finding [evidence of longer domain names incorporating proposed mark] less probative of common usage” where other evidence of record “demonstrate[d] the opposite”; “Unlike ‘hotels’ or ‘lawyers,’ ‘booking’ is used to describe a plethora of reservation services, including, for example, theatrical or musical engagements.”), *aff’d* 2020 USPQ2d 10729.

Some of Applicant’s own use of RESERVATIONS.COM further suggests that it may not be perceived as having trademark significance. For example, as shown in the image below, Applicant displays “Reservations.com” in the same font size, style and color as the generic words “Customer Support/Service Portal” such that the ordinary consumer may perceive RESERVATIONS.COM as merely identifying the subject of the customer support services, e.g. customer support for a hotel reservation website.



In some instances, as shown in the example below, Applicant displays the variation **RESERVATIONS.COM** directly opposite a telephone icon coupled with the word RESERVATIONS such that consumers might perceive RESERVATIONS.COM as generic for lodging reservation services offered online and the telephone icon coupled with the word RESERVATIONS as generic for lodging reservation services accessed by phone.

²² April 22, 2019 Specimen, TSDR 5 (this image has been cropped).

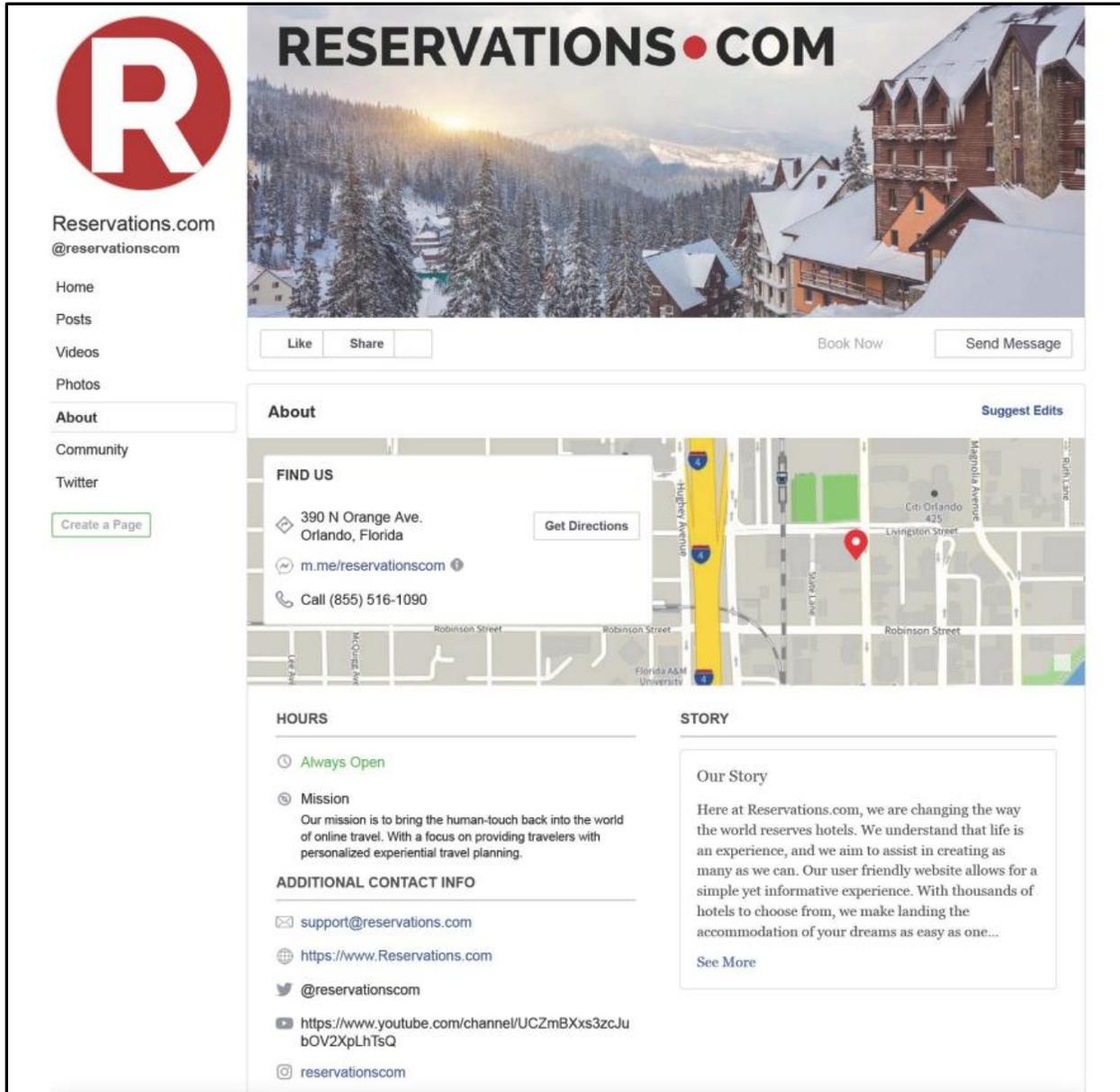


Although the evidence discussed above supports finding genericness, we must consider the evidence suggesting that consumers may perceive RESERVATIONS.COM as capable of identifying a single source of the services. *See Booking.com, 2020 USPQ2d 10729, at *6.*

The record shows that on its website and Facebook page, as well as in its Google and Google Auction Marketplace advertising, Applicant consistently displays the proposed mark with initial capitalization or in all capital letters. A representative example is shown below:²⁴

²³ May 11, 2021 Office Action, TSDR 99.

²⁴ January 6, 2020 Office Action Response, TSDR 22, 87-88, Jonna Affidavit, ¶ 13 and Exhibit 7 (this image has been cropped). Use of **RESERVATIONS • COM** may not technically show use of the proposed standard character mark RESERVATIONS.COM given that the “.” between “reservations” and “com” is raised, in the nature of a design feature, but this stylization generally corroborates Applicant’s use of RESERVATIONS.COM in a prominent, source-identifying manner and we consider the stylized display of **RESERVATIONS • COM** in that context.



Notwithstanding the two examples discussed on pages 16-18 above, for the most part, Applicant's manner of display is consistent with trademark use. *Country Music Assoc.*, 100 USPQ2d at 1831 (“[I]n the English language, initial capitalization of a term or phrase is generally used to designate a brand name, as opposed to a generic term.”). Importantly, however, simply because Applicant intends that RESERVATIONS.COM serve as a trademark and, in some instances, uses it in a

manner typical of trademark use does not dictate that consumers will primarily understand RESERVATIONS.COM as capable of serving as a source identifier. *In re Cosmetic Factory, Inc.*, 220 USPQ 1103, 1104 (TTAB 1983) (“While applicant may have adopted the subject matter for registration with the intention that it would function as a trademark and may use it in such a manner suitable to trademarks, it has long been held that not all designations are capable of functioning as trademarks notwithstanding that they have been adopted with the intent of doing so.”) (citation omitted); *see also In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 2022 USPQ2d 115, at *4 (Fed. Cir. 2022) (affirming Board’s finding that while use of .SUCKS in stylized lettering may indicate applicant’s desire for the term to serve as a source identifier, it “does not mean that consumers will perceive it as such”).

The record also includes at least eight third-party articles recognizing Reservations.com as a proprietor of services, as opposed to a class of services, and displaying RESERVATIONS.COM “in initial capital format, the standard method for indicating trademark significance” to refer to Applicant and its travel reservation services. *Country Music Assoc.*, 100 USPQ2d at 1830. Below is an excerpt from one such article:

May 3, 2019 article from Newstrail titled “5 Ways **Reservations.com** will disrupt the travel industry with AI and human touch”: “**Reservations.com** is a technology-driven travel platform that will likely disrupt the market with a very unique concept. ... Service is treated as a cost-center and is not a core focus for OTAs [online travel agencies] today.” (January 6, 2020 Office Action Response, TSDR 75-78).

The number of articles is not substantial and we do not know the circulation of the publications or page views for the articles but we find the articles associating RESERVATIONS.COM with Applicant are probative that RESERVATIONS.COM may be capable of being perceived as a source identifier for Applicant's travel reservation services. *Accord Country Music Assoc.*, 100 USPQ2d at 1833 (expert linguist's report "showing virtually all sampled written usages [in articles in Lexis/Nexis database] of the phrase COUNTRY MUSIC ASSOCIATION refer to applicant ... sufficient to raise doubts regarding the genericness of applicant's mark").

We further consider the consumer reviews of Applicant's services to the extent they are representative of some consumers' perceptions and indicate whether, to those consumers, RESERVATIONS.COM conveys an association with a particular website or a type of website. The reviews suggest that some consumers did not initially perceive RESERVATIONS.COM in the URL address of Applicant's website as distinguishing particular services offered by Applicant, but rather believed they were on the reservation page of the particular hotel website with which they wished to reserve a room. Below is a representative example of one such review:

March 13, 2017: "Has anyone else been scammed by reservations.com? I googled what appeared to be the hotel site of a hotel near Yosemite – cedarlodge.reservations.com – to add a second [room] to an existing reservation.... Nowhere on cedarlodge.reservations.com were there any terms and conditions other than those of the hotel. ... When I later called to cancel the reservation I was informed I had not made it with the hotel but rather, the clerk thought, through Expedia. It took me a while to discover that I had actually booked through reservations.com. ..." (May 11, 2021 Office Action, TSDR 86, Elliott Advocacy Help Forums, "Warning regarding reservations.com").

Generally, the reviews reflect that the consumers eventually understood that they made their reservations through Applicant's website suggesting that the proposed mark may be capable of serving as a source identifier. Additional reviews further support consumer perception of RESERVATIONS.COM as a particular website and not a type of website for travel reservation services. The following is a representative example:

2018 (full date unavailable): "**Reservations.com** is the worst 3rd party site as they charge for room, tax, reservation fees that are not-refundable even if you cancel. Expedia, Hotels.com, Booking.com, Trivago, Priceline.com just to name a few are 3rd party websites that charge full rack rates." (October 30, 2020 Final Office Action, TSDR 81, TripAdvisor, topic "Reservations.com is a scam").

We turn next to Applicant's consumer survey. Applicant employed Dr. Peterson to conduct a Teflon survey²⁵ to determine consumer perception of the proposed mark RESERVATIONS.COM for "hotel and rental car booking services."²⁶ All survey respondents were drawn from Dynata, "a company that offers an Internet panel of some 60 million consumers. Its panel members frequently serve as participants in surveys offered in litigation matters."²⁷ The survey, conducted from June 8 through June 11, 2021, was intended to be "double-blind," meaning neither the survey participants nor the survey administrator (Dynata) were expressly made aware of the

²⁵ A "Teflon" survey refers to the format of the survey used in *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975) to prove that "Teflon" was not generic. J. Thomas McCarthy, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:16 (5th ed. Sept. 2023 update) (recognizing that the "*Teflon* [survey] format is the most judicially accepted format for testing genericness").

²⁶ August 11, 2021 Office Action Response, TSDR 129, Peterson Expert Report, ¶ 29.

²⁷ August 11, 2021 Office Action Response, TSDR 124, Peterson Expert Report, ¶ 14.

purpose or the sponsor of the survey.²⁸ Dr. Peterson purportedly modeled Applicant's survey methodology on the survey conducted by Hal Poret, the expert retained in *Booking.com* (the "Poret Survey").²⁹

Survey respondents were asked a number of qualifying questions, including whether within the last 12 months, they had used a website or telephone:

- To search for or make hotel or rental car arrangements?
- To order groceries or personal care items?
- To search for or make restaurant table bookings?
- To network either personally or professionally?
- To deposit or transfer money into a bank account?³⁰

Survey participants who affirmatively responded that they had made hotel or rental car arrangements through a website or by telephone in the last 12 months proceeded with the survey. Those who responded in the negative were asked whether they intended to engage in any of the specified activities in the next 6 months.³¹ Those who responded affirmatively to the second question also proceeded to the survey. Accordingly, the survey universe was comprised of individuals "21 years of age or older living in the United States" who: (1) "have used a website or telephone/cellphone to search for or make hotel or rental car arrangements in the past twelve months"; or (2) "were likely to use a website or telephone/cellphone to search for or make hotel or

²⁸ August 11, 2021 Office Action Response, TSDR 125, Peterson Expert Report, ¶ 17.

²⁹ August 11, 2021 Office Action Response, TSDR 123, Peterson Expert Report, ¶ 12.

³⁰ August 11, 2021 Office Action Response, TSDR 167, Peterson Expert Report, ¶ S7.

³¹ August 11, 2021 Office Action Response, TSDR 167, Peterson Expert Report, ¶ S8.

rental car arrangements in the six months subsequent to the survey.”³² Participants resided in 47 states and the District of Columbia.³³

The survey began by educating participants about the difference between brand names and common names.³⁴ After the “training,” participants who indicated they understood the difference between a brand name and common name were given a mini-test to gauge their understanding of the distinction.³⁵ Those participants who correctly answered the mini-test continued with the survey.³⁶

“Two independent samples [of survey participants] were employed in the survey.”³⁷ Participants in the first sample group, consisting of 429 people, were shown the following “randomly ordered set of seven stimulus terms” and for each term were asked whether the term was a brand name, common name, or they did not know:³⁸

RESERVATIONS.COM – Hotel and rental car booking services
SPORTING GOODS – Products used in sports and other physical activities
ETRADE.COM – Stock and investor broker services
PEPSI – Cola and other soft drinks
SHUTTERFLY – Photo sharing and photo gift services
WASHINGMACHINE.COM – Reviews and sales of washing machines

³² August 11, 2021 Office Action Response, TSDR 124, Peterson Expert Report, ¶ 13.

³³ August 11, 2021 Office Action Response, TSDR 125, Peterson Expert Report, ¶ 16. Survey participants were nearly evenly split with respect to gender and fell into various age brackets.

³⁴ August 11, 2021 Office Action Response, TSDR 127-28, Peterson Expert Report, ¶ 24. The names used to educate participants about the difference between brand names and common names were TOYOTA, CHASE and STAPLES.COM (brand names) and AUTOMOBILE, BANK and OFFICESUPPLIES.COM (common names).

³⁵ August 11, 2021 Office Action Response, TSDR 128, Peterson Expert Report, ¶ 24. The names in the mini-test were KELLOGG (brand name) and CEREAL (common name).

³⁶ August 11, 2021 Office Action Response, TSDR 129, Peterson Expert Report, ¶ 24.

³⁷ August 11, 2021 Office Action Response, TSDR 124, Peterson Expert Report, ¶ 15.

³⁸ August 11, 2021 Office Action Response, TSDR 124, 129, Peterson Expert Report, ¶¶ 16, 29.

SUPERMARKET – Retail sale of food and other groceries

“With the exception of the term RESERVATIONS.COM, all terms were the same used in the Poret [S]urvey.”³⁹ All 429 participants in the first sample group viewed all names in the list, although “the questionnaire was dynamic,” as survey participants were exposed to the stimulus terms in varying order.⁴⁰ The results are as follows:⁴¹

Percentage Responses			
Term	Brand Name	Common Name	Don't Know
RESERVATIONS.COM	58	Not provided	Not provided ⁴²
SPORTING GOODS	3	97	-
ETRADE.COM	86	12	2
PEPSI	94	6	-
SHUTTERFLY	91	7	2
WASHINGMACHINE.COM	42	52	6
SUPERMARKET	2	98	-

³⁹ August 11, 2021 Office Action Response, TSDR 129, Peterson Expert Report, ¶ 29.

⁴⁰ August 11, 2021 Office Action Response, TSDR 130, 185-88, Peterson Expert Report, ¶ 31 and Exhibit 4 thereto.

⁴¹ August 11, 2021 Office Action Response, TSDR 130-31, Peterson Expert Report, ¶¶ 32, 33.

⁴² Dr. Peterson did not provide the percent responses in these categories for the first group of 429 participants who were asked about all seven names in the chart. No explanation has been provided for the omission of this information and the lack of data undermines the reliability of Dr. Peterson’s report and conclusion.

The second sample group, consisting of 132 participants, “were only asked to respond to a single stimulus term, RESERVATIONS.COM” and “asked whether they thought it was a brand name, a common name, or whether they did not know.”⁴³ Applicant’s expert, Dr. Peterson, explained that “the purpose of the second sample was to address possible survey ‘noise’ due to the randomization process used when measuring perceptions of the seven terms.”⁴⁴ Sixty-seven percent of respondents in the second “sample” group identified RESERVATIONS.COM as a brand for “hotel and rental car booking services.”⁴⁵

The survey concluded by asking participants whether they had followed the survey instructions and whether they, or anyone in their household, worked for a hotel or rental car company, and whether in the last three months they had participated in an Internet survey regarding brand names or common names.⁴⁶ Only the responses of those participants who answered these questions in the negative were “included in the [survey] data analysis.”⁴⁷

Dr. Peterson totaled the results of the two surveys together.⁴⁸ Of the 561 total participants, “a majority, approximately 60 percent, perceived the term

⁴³ August 11, 2021 Office Action Response, TSDR 124-25, 130, Peterson Expert Report, ¶¶ 16, 30.

⁴⁴ August 11, 2021 Office Action Response, TSDR 130, Peterson Expert Report, ¶ 30.

⁴⁵ August 11, 2021 Office Action Response, TSDR 131, Peterson Expert Report, ¶ 33.

⁴⁶ August 11, 2021 Office Action Response, TSDR 130, Peterson Expert Report, ¶ 31.

⁴⁷ August 11, 2021 Office Action Response, TSDR 130, Peterson Expert Report, ¶ 31.

⁴⁸ August 11, 2021 Office Action Response, TSDR 131, Peterson Expert Report, ¶ 32.

[RESERVATIONS.COM] to be a brand name.”⁴⁹ Dr. Peterson reasons that “the conclusion to be drawn from the survey is straightforward.” Based on the “majority of the target universe, 60 percent, perceiv[ing] the term RESERVATIONS.COM to be a brand name not a common name[.]” Dr. Peterson opines that “RESERVATIONS.COM is not a generic term.”⁵⁰

Applicant argues there is no basis for “attack[ing]” Applicant’s survey because “[t]he primary research methodology used in Applicant’s genericness survey was **accepted** by the U.S. Supreme Court in *Booking.com*.”⁵¹ Applicant, however, did not introduce a copy of the Poret Survey used in *Booking.com* for comparison. Moreover, the acceptability of the survey was not before the Supreme Court in *Booking.com*. *Booking.com*, 2020 USPQ2d 10729, at *7 n.6 (stating that “the PTO does not contest the lower courts’ assessment of consumer perception in this case”). Notably, the Court observed that “[s]urveys can be helpful evidence of consumer perception but require care in their design and interpretation.” *Id.* at *7, n.6.

Accordingly, we must consider the particular survey conducted in this proceeding and the results thereof. *Hotels.com*, 91 USPQ2d at 1536 (“Survey evidence is subject to review for its probative value, based on factors including the design of the survey, the questions asked, and the experience of the surveyor.”). As discussed below, there are a number of problems with Applicant’s survey.

⁴⁹ August 11, 2021 Office Action Response, TSDR 131-32, Peterson Expert Report, ¶ 32.

⁵⁰ August 11, 2021 Office Action Response, TSDR 131, Peterson Expert Report, ¶ 34.

⁵¹ Appeal Brief, 17 TTABVUE 12 (Applicant’s emphasis in the original in italics).

Applicant's survey "was modeled after the Teflon-style survey in the Booking.com case[.]" 17 TTABVUE 17. As noted, a "Teflon" survey is a generally accepted format for testing genericness. 2 MCCARTHY ON TRADEMARKS § 12:16. Such a survey starts with educating survey participants on the difference between brand names and common names and then tests participants' understanding of the difference between the two categories. *Country Music Assoc.*, 100 USPQ2d at 1831, n.4 (for "description of 'Teflon' consumer methodology" see *DuPont v. Yoshida* 185 USPQ at 615 (using the example of Chevrolet (brand name) and automobile (common name)). Participants who understand the distinction then proceed to the main portion of the survey where they are presented with a list of names and asked whether the names in the list are brand names or common names. *DuPont v. Yoshida* 185 USPQ at 615.

Here, the educational component of Dr. Peterson's survey and the mini screening test administered to survey participants were flawed. Even though the survey was intended to test consumer recognition of RESERVATIONS.COM, only two of the six names used to educate survey participants on the difference between common and brand names were ".com" names, and neither term in the mini test used to test participants' understanding of the difference between a common name and brand name was a ".com" name. The failure to educate and screen survey participants about whether they understood the difference between a generic domain name and a domain name that functions as a brand was "a critical omission ... radically skewing the results of the survey in [A]pplicant's favor." *In re Hotels.com, L.P.*, 87 USPQ2d 1100, 1109 (TTAB 2008) (survey intended to test consumer perception of

HOTELS.COM made a “critical omission” when screening consumer understanding of brand name versus common name by failing to screen whether participants understood “the conceptual difference between a domain name and a brand name, or even recognize that there is a difference”).

The fact that a rather large percentage of respondents (42%) in Applicant’s survey incorrectly identified WASHINGMACHINE.COM as a brand name demonstrates that the educational and mini-test portions of the survey were disproportionately ineffective and that some participants in the survey may have been predisposed to believe that every generic.com designation functions as a brand name.⁵² See *Hotels.com*, 87 USPQ2d at 1109 (“Although we can assume that consumers will recognize HOTELS.COM as a domain name, we cannot assume that they understand the conceptual difference between a domain name and a brand name, or even recognize that there is a difference. Many consumers may automatically equate a domain name with a brand name, believing they both serve the same function.”), *aff’d* 19 USPQ2d 1532 (Fed. Cir. 2009). Indeed, in *Booking.com*, the Supreme Court recognized that “a consumer who is familiar” with the fact that only one entity can occupy a particular domain name “can infer” that a generic.com term “refers to some specific entity,” *Booking.com*, 2020 USPQ2d 10729, at *6 (quoting Petitioner’s brief)

⁵² Six percent of all respondents did not know if WASHINGMACHINE.COM was a brand name or common name. August 11, 2021 Office Action Response, TSDR 131, Peterson Expert Report, ¶ 32. Eighty-six percent of respondents identified the only other dot-com name in the survey, ETRADE.COM, as a brand name. *Id.*

(internal quotations omitted), and therefore, may mistakenly believe that any generic.com is a brand name.

The main test portion of the survey also is flawed. Dr. Peterson asserts that he conducted a single Teflon survey comprised of “[t]wo independent samples” consisting of: (1) 429 participants who were exposed to seven test words, including RESERVATIONS.COM; and (2) 132 participants who were exposed only to the term RESERVATIONS.COM. The second “sample,” however, was actually a second survey that did not follow the Teflon-style methodology (the “Second Survey”).

By its nature, a “Teflon” survey presents participants with a list of names and asks whether the names in the list are brand or common names. *DuPont v. Yoshida* 185 USPQ at 615 (asking participants whether each of eight names, including TEFLON, was a brand name or common name.); 2 MCCARTHY ON TRADEMARKS § 12:16 (“In designing a TEFLON-type survey, both the initial and ‘mini-test’ and the other marks and generic names in the list must be carefully constructed and tailored to the facts of a particular case.”). The additional names in a Teflon survey are “control” names designed to assess whether the survey respondents truly understand the difference between brand names and common names. *Sheetz of Del.*, 108 USPQ2d at 1359 (“We see nothing wrong with [the Teflon survey’s] use of COCA-COLA and GATORADE [in list of names] because they act as control terms demonstrating that the respondents understand the difference between common names and brand names.”); *cf. Zimmerman v. Nat’l Assoc. of Realtors*, 70 USPQ2d 1425, 1436 n.16 (TTAB 2004) (“Because a control question generally has a correct answer, the

magnitude of survey participants who fail on a control question (the ‘noise’) will be viewed as evidence of guessing, inattention and/or other extraneous factors, and will be used to adjust the percentages of answers to the key question in order to get an accurate measurement of the ‘true’ beliefs within the population about the key question.”). Without any control names in the main portion of the Second Survey, we are not sufficiently able to ascertain which of the 132 participants actually understood the difference between a brand name and a common name.

Dr. Peterson explained that he conducted the Second Survey “to address possible survey ‘noise’ due to the randomization process used when measuring perceptions of the seven terms.”⁵³ Applicant further explains in its brief that Dr. Peterson “slightly modified the methodology based on criticism of the survey by Ed Blair, the expert for the USPTO in the *Booking.com* case.”⁵⁴ In *Booking.com*, Dr. Blair criticized the Poret Survey on the ground that the survey responses “varied based on the order in which the [brand names and common names] were presented, which [Dr. Blair] posit[ed] [was] an indication that respondents did not understand the distinction between dot-com brand names and common names and were answering based on context rather than actual knowledge.” *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 918 (EDVA 2017), *aff’d* 2020 USPQ2d 10729. The district court, however, was satisfied with Dr. Poret’s explanation that “all Teflon surveys have order effects, irrespective of whether they test dot-com or other marks” and “[t]he very reasons that [Teflon] surveys

⁵³ August 11, 2021 Office Action Response, TSDR 130, Peterson Expert Report, ¶ 30.

⁵⁴ Applicant’s Brief, 17 TTABVUE 12.

include various orderings of the terms ... is because it is well known and expected that responses to terms often vary in this manner' and 'providing various orderings is designed to control for this phenomenon.'" *Id.* ("[N]o survey is perfect.") (quoting *Selchow & Righter Co. v. Decipher, Inc.*, 598 F. Supp. 1489, 225 USPQ 77, 86 (EDVA 1984).

Here, in the Teflon survey of 429 participants (the "First Survey"), Dr. Peterson rotated the names in the list just like the Poret Survey in *Booking.com* and, therefore, controlled for any bias as a result of the order of the terms. So we are perplexed as to why Dr. Peterson conducted the Second Survey. Removing all control terms from the Second Survey significantly undermines the reliability of the survey results rather than strengthens them.

Another problematic aspect of the Second Survey is that it was not "double-blind" as Dr. Peterson contends. Because participants in the Second Survey were presented only with the name RESERVATIONS.COM, they clearly were aware that the survey was designed to test consumer perception of that term. Knowing the purpose of the survey may have encouraged participants to guess whether RESERVATIONS.COM was a brand name or common name such that the results are unreliable.

To this end, 67% of respondents in the Second Survey identified RESERVATIONS.COM as a brand name compared to only 58 percent of the 429 respondents in the First Survey. Dr. Peterson asserts that "[t]he [9%] difference between the two percentages [is] not statistically significant" and is attributable, "at least in part, to the randomization approach employed when measuring perceptions

of seven terms.”⁵⁵ But the higher percentage of respondents in the Second Survey who identified RESERVATIONS.COM as a brand name was just as likely a result of participants in the Second Survey knowing the purpose of the survey and, therefore, some may have been guessing when identifying RESERVATIONS.COM as a brand name.

In addition, the responses to the First Survey are far less favorable than the responses to the Poret Survey in *Booking.com*. Fifty-eight percent of participants in the First Survey identified RESERVATIONS.COM as a brand name for “hotel and rental car booking services” compared with 74.8% participants who identified BOOKING.COM as a brand name for “online travel services” in the Poret Survey. *Booking.com*, 278 F. Supp. 3d at 915, *aff’d* 2020 USPQ2d 10729. Further, 42% of participants in Applicant’s First Survey incorrectly identified WASHINGMACHING.COM as a brand name for “reviews and sales of washing machines”⁵⁶ while only 33% of participants in the Poret Survey incorrectly identified WASHINGMACHINE.COM as a brand name for such services. *Id.* at 917. The difference in the percentage of participants in this case who identified RESERVATIONS.COM as a brand name versus those who identified WASHINGMACHINE.COM as a brand name is only 16% – far lower than the 41.8% difference between the terms BOOKING.COM and WASHINGMACHINE.COM in the Poret Survey.

⁵⁵ August 11, 2021 Office Action Response, TSDR 131, Peterson Expert Report, ¶ 33.

⁵⁶ As explained, participants in Dr. Peterson’s Second Survey were not asked whether WASHINGMACHINE.COM was a brand name or common name.

Further, in response to criticism that the educational component of the Poret Survey in *Booking.com* “did not focus specifically on dot-com names and respondents were not tested on their ability to distinguish between dot-com brand names and dot-com common names,” Dr. Poret “remov[ed] the respondents who answered that WASHINGMACHINE.COM [was] a brand name” from the survey results. *Id.* at 917. The number of remaining participants who identified BOOKING.COM as a brand name was 65%. *Id.* at 917-18. Here, if we were to remove from the results of the First Survey the 42% of participants (approximately 180) who incorrectly identified WASHINGMACHINE.COM as a brand name, we are left with 249 participants.⁵⁷ The record, however, does not reflect how many of these remaining 249 participants identified RESERVATIONS.COM as a brand name. Accordingly, unlike in *Booking.com*, Applicant here did not “control” for those survey respondents who may have been predisposed to think that any dot-com name is a brand name. The absence of this “control” information is significant.

In addition, survey control terms should differ from the test stimulus only to the minimal degree necessary. *See* Shari Seidman Diamond, “Reference Guide on Survey Research,” REFERENCE MANUAL ON SCIENTIFIC EVIDENCE, at p.399 (3d ed., Nat’l Acad. Press 2011) (explaining that a survey control should share “as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.”). Here, only two of the six control

⁵⁷ Forty-two percent of 429 participants is approximately 180 participants. Four hundred twenty nine minus 180 participants is 249 participants.

terms were comprised of [word].com names similar to the stimulus term RESERVATIONS.COM. This further undermines our confidence in the results of the First Survey. *Hotels.com*, 87 USPQ2d at 1109 (criticizing survey intended to test consumer recognition of HOTELS.COM because only one stimuli, AMAZON.COM, was a “.com” name).

The surveys also did not pose a follow-up question asking participants why they categorized each stimulus term as a “brand name,” “common name,” or “don’t know.” Such a follow-up question is important when surveying a “.com” name because a domain name can only be owned by a single entity, potentially leading to the mistaken belief that all domain names are source indicators.⁵⁸

Although the flaws in the First Survey diminish its probative value, it is not devoid of significance. We consider the results of the First Survey to the extent they provide some corroboration for the consumer reviews suggesting that the proposed mark may be capable of serving to identify the source of Applicant’s services. For the reasons explained, we find the Second Survey has little, if any, probative value.

Finally, we address the testimony of Mahesh Chaddah, one of Applicant’s officers, that he is not aware of anyone using RESERVATIONS.COM as a generic term for

⁵⁸ The Examining Attorney further criticizes the survey on the ground that “Dynata survey participants are paid for each completed survey” and “to receive money for completing each survey, participants must answer the questions in a certain manner in order to move to the next question and to ultimately complete the survey.” October 18, 2021, TSDR 5, Second Final Office Action. We find this argument unpersuasive. Any valid Teflon survey must qualify respondents before asking them the main questions. Dynata did that here, administering the disqualification questions in the survey as designed by Dr. Peterson. The record in this case does not support that compensating people to take the surveys tainted the respondent pool. The Examining Attorney’s argument, in the absence of stronger evidentiary support, is mere speculation.

Applicant's services;⁵⁹ that he is not aware of anyone using RESERVATIONS.COM "in any way other than to refer to [his] company";⁶⁰ and that based on his "contact with thousands of clients and potential clients throughout the United States" it is his "impression" that consumers perceive RESERVATIONS.COM as a trademark.⁶¹

We give this self-serving testimony little weight. *In re Cent. Cntys. Bank*, 209 USPQ 884, 888 (TTAB 1981) ("The statement[s] by applicant's officials [of consumer recognition of applied-for term as a source indicator] are self-serving statements that are entitled, under the circumstances herein, to little, if any, probative value on the registrability question."). It is not surprising that, as an officer of Applicant, Mr. Chaddah has not heard RESERVATIONS.COM used "in any way other than to refer to [his] company."⁶² Mr. Chaddah's conclusion regarding consumer understanding is conclusory and cannot substitute for our own legal determination of the genericness refusal. *Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at *19-20 (TTAB 2021) (conclusory testimony unpersuasive); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1755, 1757 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.) (disregarding "any opinion testimony regarding the ultimate disposition of the claims asserted" including that a registered mark was generic or merely descriptive and had not acquired distinctiveness; witness opinion cannot "serve as a substitute for the Board's judgment on the legal claims before us").

⁵⁹ August 11, 2021 Office Action Response, TSDR 23, Second Chaddah Affidavit, ¶ 19.

⁶⁰ August 11, 2021 Office Action Response, TSDR 23, Second Chaddah Affidavit, ¶ 18.

⁶¹ August 11, 2021 Office Action Response, TSDR 23, Second Chaddah Affidavit, ¶ 17.

⁶² August 11, 2021 Office Action Response, TSDR 23, Second Chaddah Affidavit, ¶ 18.

Most importantly, whether RESERVATIONS.COM is **used** as a generic term is irrelevant if consumers primarily **understand** the proposed mark as a generic term for Applicant's services. *1800Mattress.com*, 92 USPQ2d at 1685 ("The test is not only whether the relevant public would itself *use* the term to describe the genus, but also whether the relevant public would *understand* the term to be generic. Thus, it is irrelevant whether the relevant public refers to online mattress retailers as 'mattress.com.'").

E. Conclusion on Genericness

"Genericness is a fact-intensive determination and the Board's conclusion must be governed by the record which is presented to it." *Country Music Assoc.*, 100 USPQ2d at 1832. "[A]ll evidence bearing on public perception must be given appropriate consideration." *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1958 (TTAB 2018).

We find that the Examining Attorney established a prima facie case of genericness. The third-party domain names are particularly probative. As noted, however, we are presented with the unique circumstance of determining whether a compound designation formed by a generic term followed by ".com" is, as a whole, generic. Here, the consumer reviews ultimately reflect consumer understanding of RESERVATIONS.COM as identifying a particular website, as opposed to a class of travel reservation websites. The First Survey corroborates the consumer reviews and as such has some value despite its numerous flaws. Applicant's own use of the term

further supports a finding that consumers may perceive RESERVATIONS.COM as a source-identifier.

We are constrained on this record to find that the evidence rebuts the Examining Attorney's prima facie case and shows that Applicant's proposed mark is capable of serving as a mark for Applicant's services. The genericness refusal is reversed.⁶³

III. Refusal that Applicant's Proposed Mark is Merely Descriptive of Applicant's Services and has Not Acquired Distinctiveness

We now turn to the second ground for refusal, namely, that the proposed mark RESERVATIONS.COM is merely descriptive of Applicant's services and has not acquired distinctiveness through use in commerce. Trademark Act Section 2(f), 15 U.S.C. § 1052(f) (“[N]othing [in this section] shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.”). The Examining Attorney argues that Applicant's evidence of acquired distinctiveness is insufficient because RESERVATIONS.COM is highly descriptive of Applicant's services. Applicant, on the other hand, argues that RESERVATIONS.COM is suggestive of its services or, in the alternative, has acquired distinctiveness as a source indicator.

A. Applicant's Proposed Mark is Highly Descriptive

Based on the evidence discussed in the genericness section above, we find that the proposed mark “is much closer to the generic than suggestive line” on the spectrum of distinctiveness and, thus, is highly descriptive of Applicant's travel reservation

⁶³ On a different record, we might reach a different result.

services for temporary lodging and auto transportation under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). *GJ & AM*, 2021 USPQ2d 617, at *36 (finding COOKINPELLETS.COM “highly descriptive” of applicant’s “processed wood fuel in the nature of pellets for use in barbecue grills”; “The evidence discussed above in connection with the genericness refusal is equally probative on the question of the level of descriptiveness of Applicant’s asserted mark, because the two inquiries are so closely related.”); *In re Steelbuilding.com*, 75 USPQ2d at 1424 (STEELBUILDING.COM highly descriptive of “computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems”); *Sausser Summers*, 2021 USPQ2d 618, at *8 (proposed mark ONLINETRADEMARKATTORNEYS.COM “highly descriptive” of “legal services”); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1900 (TTAB 2001) (RUSSIANART, if not generic, is “very highly descriptive” of “dealership services in the field of fine art, antiques, furniture and jewelry”); *In re Log Cabin Homes, Ltd.*, 52 USPQ2d 1206, 1211 (TTAB 1999) (LOG CABIN HOMES “very highly descriptive” of “architectural design of buildings, especially houses, for others, and retail outlets featuring kits for constructing buildings, especially houses”).

B. Whether Applicant has Demonstrated that RESERVATIONS.COM has Acquired Distinctiveness as a Source Identifier for Applicant’s Services

Because we have found that RESERVATIONS.COM is highly descriptive of Applicant’s services, Applicant bears a heavy burden of establishing acquired distinctiveness. *Sausser Summers*, 2021 USPQ2d 618, at *7 (quoting *Royal Crown*,

127 USPQ2d at 1048) (“[T]he greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.”); *GJ & AM*, 2021 USPQ2d 617, at *37-38 (“Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of acquired distinctiveness thus will ordinarily be required to establish that such terms truly function as source indicators.”); *Virtual Indep. Paralegals*, 2019 USPQ2d 111512, at *10 (“[T]he greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness.”) (quoting *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1085 (TTAB 2010)).

“[T]o establish that a term has acquired distinctiveness, an applicant must show that in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *In re La. Fish Fry Prods.*, 797 F.3d 1332, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (citation omitted); see also *GJ & AM*, 2021 USPQ2d 617, at *38 (“To establish acquired distinctiveness, an applicant must demonstrate that relevant consumers perceive the subject matter sought to be registered as identifying the producer or source of the product.”) (citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) and *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009)); see also *Uman Diagnostics*, 2023 USPQ2d 191, at *37 (“[T]o be placed on the principal register, descriptive terms must achieve significance ‘in the minds of the public’ as identifying the applicant’s goods or services

– a quality called acquired distinctiveness’ ...” (quoting *Booking.com*, 2020 USPQ2d 10729, at *3).

“Applicant may show acquired distinctiveness by direct or circumstantial evidence.” *GJ & AM*, 2021 USPQ2d 617, at *38-39 (“Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which we may infer a consumer association, such as years of use, prior registrations, extensive amount of sales and advertising, unsolicited media coverage, and any similar evidence showing wide exposure of the mark to consumers.”). In particular, we consider evidence bearing on the following factors: (1) association of the proposed mark with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the services identified by the proposed mark. *Converse, Inc. v. Int’l Trade Comm’n*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018); *GJ & AM*, 2021 USPQ2d 617, at *39 (acknowledging the six factors the Federal Circuit has identified “to consider in assessing whether a mark has acquired distinctiveness”). We consider all of the Section 2(f) evidence of record as a whole. *Converse*, 128 USPQ2d at 1546 (“All six factors are to be weighed together in determining the existence of secondary meaning.”); *In re SnowWizard, Inc.*, 129 USPQ2d 1001, 1008 (TTAB 2018) (determining acquired distinctiveness by “weighing all of the factors for which there is evidence”); *GJ & AM*, 2021 USPQ2d 617, at *39.

1. Factor One: Association of the Proposed Mark with a Particular Source by Actual Purchasers

Applicant points to its Teflon survey⁶⁴ to support its assertion that RESERVATIONS.COM functions as a mark. Teflon surveys may be introduced as evidence that a proposed mark is not generic and has acquired distinctiveness. *Country Music Assoc.*, 100 USPQ2d at 1834 (“[A]lthough the [Teflon] consumer survey conducted by Dr. Ford was submitted in connection with the issue of genericness, the acquired distinctiveness of the term COUNTRY MUSIC ASSOCIATION among the relevant purchasing public can be inferred from the results.”); *see also Booking.com, B.V.*, 278 F. Supp. 3d at 920 (citing numerous cases in support of the proposition that “[a]lthough primarily used to determine whether a mark is generic, Teflon surveys are also a generally accepted way of measuring secondary meaning”), *aff’d* 2020 USPQ2d 10729; 6 MCCARTHY ON TRADEMARKS § 32:191 (“Courts agree” with the Board that a Teflon survey on genericness is pertinent to the issue of acquired distinctiveness”).

In the genericness determination above, we found that despite flaws in methodology, the First Survey had some evidentiary value as to whether the proposed mark, consisting of a generic.com domain name, is capable of serving a source-identifying function. Specifically, we took into account that the survey provided some corroboration for the consumer reviews suggesting that Applicant’s proposed mark is

⁶⁴ Applicant’s expert Dr. Peterson asserts that he conducted one survey comprised of “[t]wo independent samples” of participants. August 11, 2021 Office Action Response, TSDR 124, Peterson Expert Report, ¶ 15. For the reasons discussed in the genericness section above, we find Applicant actually conducted two surveys.

capable of serving as a source identifier. Nonetheless, we find the survey flaws are too great and numerous to support a finding of acquired distinctiveness. The consumer reviews similarly fall short of supporting a conclusion that RESERVATIONS.COM has achieved such recognition among consumers, particularly as many consumers initially mistakenly believed the proposed mark referred generically to a reservation page for specific hotel websites.

2. Factor Two: Length, Degree, and Exclusivity of Use

Under factor two, Applicant introduced the declaration of its attorney, Amber Davis, who avers that the proposed mark “has become distinctive of the goods/services through the applicant’s substantially exclusive and continuous use of RESERVATIONS.COM in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.”⁶⁵ Messrs. Jonna and Chaddah more specifically aver that Applicant has been using RESERVATIONS.COM “since at least as early as 2014” in connection with “a website at www.reservations.com wherein customers can make lodging and auto transportation reservations. Customers can also make lodging and auto transportation reservations over the phone.”⁶⁶ Mr. Chaddah further avers that he is “not aware of anyone else who uses RESERVATIONS.COM as a mark for the services claimed in the ‘223 Application.”⁶⁷

⁶⁵ July 14, 2020 Office Action Response, TSDR 7.

⁶⁶ January 6, 2020 Office Action Response, TSDR 20-21, Jonna Affidavit, ¶¶ 4-5; August 11, 2021 Office Action Response, TSDR 21, Second Chaddah Affidavit, ¶¶ 4, 6.

⁶⁷ August 11, 2021 Office Action Response, TSDR 21, Second Chaddah Affidavit, ¶ 8.

The record here includes numerous examples of third parties using domain names incorporating “reservation(s).com” and offering travel reservation services for temporary accommodations, including the domain names hotel-reservations.com, thehotelreservations.com, and worldwide-hotelreservations.com.⁶⁸ This evidence severely undercuts the averment of Applicant’s counsel that Applicant has made “substantially exclusive” use of RESERVATIONS.COM for Applicant’s services as necessary to acquire distinctiveness. *See, e.g., Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness upon which purchasers may rely is lacking under such circumstances.”); *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1404 (TTAB 2016) (finding no “substantially exclusive” use where there was widespread third-party use of the proposed mark for applicant’s services); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1357-58 (TTAB 1989) (“[T]he existence of numerous third-party users of a mark, even if junior, might well have a material impact on the Examiner’s decision to accept a party’s claim of distinctiveness.”).

Moreover, Applicant’s use of the proposed mark RESERVATIONS.COM since 2014 is not particularly persuasive on the Section 2(f) showing given the high degree of descriptiveness of Applicant’s proposed mark and the noted third-party uses. *See, e.g.,*

⁶⁸ May 11, 2021 Office Action, TSDR 120, 124-31; *see also id.* at 7, 35-36, 89-98, 121-23; October 30, 2020 Final Office Action, TSDR 10-12, 20.

La. Fish Fry Prods., 116 USPQ2d at 1265 (“Particularly for a mark that is as highly descriptive [as] FISH FRY PRODUCTS, the Board was within its discretion not to accept Louisiana Fish Fry’s alleged five years of substantially exclusive and continuous use as *prima facie* evidence of acquired distinctiveness.”); *Uman Diagnostics*, 2023 USPQ2d 191, at *41 (citing *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988)) (“While ‘it is true that evidence of substantially exclusive use for a period of five years immediately preceding the filing of an application may be considered prima facie evidence of acquired distinctiveness’ under Section 2(f), *In re Ennco Display Sys., Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000), the ‘language of the statute is permissive, and the weight to be accorded this kind of evidence depends on the facts and circumstances of the particular case.’ We have discretion to find that evidence of a period of use is insufficient to show acquired distinctiveness, and we do so here because of the highly descriptive nature of Applicant’s proposed mark.”); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *20 (TTAB 2020) (“Where, as here, the applied-for mark is highly descriptive or non-distinctive, use for a period of approximately fourteen years is insufficient to establish acquired distinctiveness.”); *Nextel Commc’ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1401 (TTAB 2009) (“Even long periods of substantially exclusive use may not be sufficient to demonstrate acquired distinctiveness” depending “on the degree of non-distinctiveness of the mark at issue.”); *Flowers Indus. Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89

(TTAB 1987) (“[L]ong and continuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive.”).

3. Factor Three: Amount and Manner of Advertising

Since 2014, Applicant has used the proposed mark RESERVATIONS.COM on its website and on “other Internet platforms, such as Facebook.”⁶⁹ Applicant “also promotes its www.reservations.com website and RESERVATIONS.COM brand via Bing, Yahoo and Google advertisements.”⁷⁰ Applicant invested approximately 220 million dollars in advertising its services from 2014 through mid-July 2021.⁷¹ “[P]ast expenditures on advertising are estimated as follows: \$2,922,316 in 2014; \$8,881,781 in 2015; \$17,279,622 in 2016; \$28,342,936 in 2017; \$34,411,333 in 2018; \$45,506,840 in 2019; \$43,031,121 in 2020 and \$39,670,698 until July 22nd 2021.”⁷²

Applicant’s advertising expenditures are significant and support Applicant’s claim of acquired distinctiveness; however, neither Mr. Chaddah nor Mr. Jonna specified whether these are U.S. advertising expenditures (as opposed to international or worldwide expenditures) so we do not know what portion of these advertising expenditures were directed to promoting Applicant’s services to U.S. consumers. *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *6 n.27 (TTAB 2019) (relevant perception is that of the U.S. consumer); *Oland’s Breweries [1971] Ltd. v.*

⁶⁹ January 6, 2020 Office Action Response, TSDR 22, Jonna Affidavit, ¶ 13.

⁷⁰ January 6, 2020 Office Action Response, TSDR 22, Jonna Affidavit, ¶ 11; August 11, 2021 Office Action Response, TSDR 23, Second Chaddah Affidavit, ¶ 13.

⁷¹ August 11, 2021 Office Action Response, TSDR 22, Second Chaddah Affidavit, ¶ 11.

⁷² August 11, 2021 Office Action Response, TSDR 22, Second Chaddah Affidavit, ¶ 11; *see also* January 6, 2020 Office Action Response, TSDR 22, Jonna Affidavit, ¶ 9.

Miller Brewing Co., 189 USPQ 481 (TTAB 1975) (use or promotion of a mark confined to a foreign country is immaterial to ownership and registration in the U.S.), *aff'd* 548 F.2d 349, 192 USPQ 266 (CCPA 1976). Importantly, there also is no evidence regarding: (i) the number of advertisements Applicant has run on the Bing, Yahoo, or Google search engines or how many posts Applicant has made to its Facebook page;⁷³ (ii) how long Applicant has promoted its services on the Bing, Yahoo and Google search engines; or (iii) U.S. consumer exposure to Applicant's advertising on Bing, Yahoo, Google, and Facebook, *e.g.* advertising impressions, social media followers. *See Booking.com*, 278 F. Supp. 3d. at 919 (finding "compelling" evidence that applicant's "BOOKING.COM branded television commercials ... received 1.3 billion visual impressions from U.S. consumers in 2015 and 1.1 billion impressions in 2016. Its internet advertisements during these years received 212 million and 1.34 billion visual impressions from U.S. customers, respectively. And its 2015 movie theater advertisements received approximately 40 million visual impressions from U.S. customers."), *aff'd* 2020 USPQ2d 10729; *see also In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) ("The advertisements of record do not support an inference of distinctiveness inasmuch as the evidence fails to disclose information from which the number of people exposed to the design could be

⁷³ Mr. Jonna testifies to "extensive" use of the proposed mark on Applicant's website, Facebook and "other Internet platforms," but Mr. Jonna does not identify the "other Internet platforms" or describe the nature of the "extensive" use. January 6, 2020 Office Action Response, TSDR 22, Jonna Affidavit, ¶ 13. *Cf. Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1184 (TTAB 2017) (indefinite testimony regarding priority of use not particularly probative); *see also, cf. Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at *20 (TTAB 2021) (probative value of testimony regarding use "significantly undermined by ... utter lack of detail").

estimated” including the “circulation of such publications in which the advertisements appear” and “number of advertisements published”).

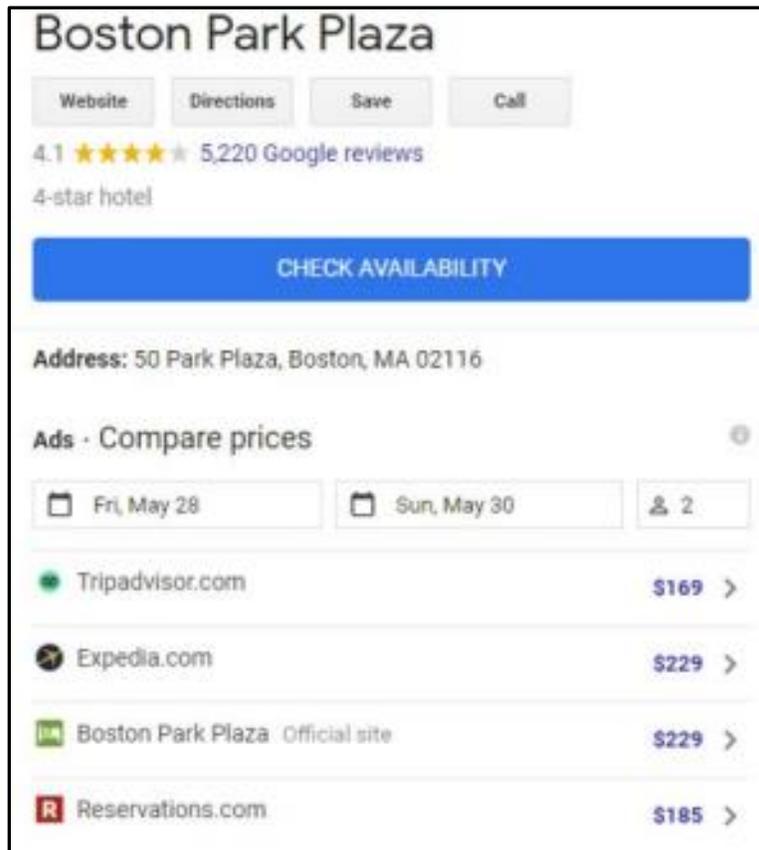
Further, Applicant did not introduce any of the advertisements it has run on Bing or Yahoo. *See* Trademark Rule 2.41(a)(3) (“advertising expenditures ... identifying types of media **and attaching typical advertisements**” pertinent to whether a proposed mark has acquired distinctiveness) (emphasis added); *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (substantial advertising expenditures but “no evidence that any of the advertising activity was directed to creating secondary meaning in applicant’s highly descriptive trade name.”); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (“[L]arge [advertising] expenditures in this regard cannot, per se, establish that the term functions as a mark to identify and distinguish services or goods rendered by an applicant. It is necessary to examine the advertising material to determine how the term is being used therein, what is the commercial impression created by such use and what it would mean to purchasers.”) (quoting *In re Redken Labs., Inc.*, 170 USPQ 526, 529 (TTAB 1971) (internal quotation marks omitted)).

The record includes a handful of Applicant’s Google advertisements and a screenshot from Applicant’s Facebook page displaying RESERVATIONS.COM with an initial capital letter, as is typical for trademark use, *Country Music Assoc.*, 100 USPQ2d at 1831, and otherwise using the term in a trademark or trade name sense rather than a descriptive manner.⁷⁴ Applicant points to screenshots from Google

⁷⁴ January 6, 2020 Office Action Response, TSDR 21, 26, Jonna Affidavit, ¶ 4 and Exhibit 1.

Auction Marketplace as demonstrating that the proposed mark “creates a unique commercial impression making it readily apparent that RESERVATIONS.COM is a third-party booking site similar to its competitors, BOOKING.COM, TRAVELOCITY and KAYAK.COM.”⁷⁵ As shown in the example below, the proposed mark is displayed

in close proximity to the logo  :⁷⁶



Consumers encountering this manner of use may perceive  Reservations.com as creating a single commercial impression such that any source-identifying

⁷⁵ Reply Brief, 20 TTABVUE 10-11.

⁷⁶ August 11, 2021 Office Action Response, TSDR 117-18, Second Chaddah Affidavit, Exhibit 7.

recognition among consumers may be of the composite designation



rather than the proposed mark RESERVATIONS.COM. Even considering that consumers would perceive RESERVATIONS.COM as creating a separate commercial impression here, because Applicant only introduced a handful of advertisements (and none from Bing or Yahoo), we do not know how frequently Applicant uses this particular manner of display.

Turning to use on Applicant's website, for the most part the record shows consistent use of RESERVATIONS.COM in a manner typical of trademark use. Mr. Chaddah avers that "[t]here are approximately 1,213,481 page views on [Applicant's] www.reservations.com website every day [based on data collected from July 15, 2018 to July 22, 2021]. On certain days, the company has had over 2 million views[.]"⁷⁷ Mr. Chaddah, however, has not testified as to whether or to what extent these page views are from U.S. consumers, and the chart corroborating Mr. Chaddah's testimony indicates that the page views are, in fact, from "All Users" not just U.S. consumers.⁷⁸ The absence of information specific to U.S. consumers reduces the persuasive value of this evidence. *In re Howard Leight Indus., LLC*, 80 USPQ2d 1507, 1517 n.12 (TTAB 2006) ("Applicant's sales of earplugs outside the United States are not probative evidence on the question of acquired distinctiveness in the United States."); *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481, 1483 (TTAB 1989) ("The relevant test is,

⁷⁷ August 11, 2021 Office Action Response, TSDR 22, Second Chaddah Affidavit, ¶ 12.

⁷⁸ August 11, 2021 Office Action Response, TSDR 112-13, Second Chaddah Affidavit, Exhibit 5.

of course, consumer perception in this country.”); *cf. Abitron Austria GmbH v. Hetronic Int’l, Inc.*, __U.S. __ , 2023 USPQ2d 760, at *11 (2023) (15 U.S.C. §§ 1114(1)(a) and 1125(a)(1) are not extraterritorial and extend only to claims where the infringing use in commerce is domestic).

In sum, the significance of Applicant’s advertising expenditures is undermined by the absence of examples of Applicant’s Bing and Yahoo advertisements, Applicant’s display of the proposed mark with a red “R” logo ( [Reservations.com](https://www.Reservations.com)) in Google Auction Marketplace advertisements, and the lack of information regarding U.S. consumer exposure to Applicant’s website and advertising.

4. Factor Four: Amount of Sales and Number of Customers

Applicant’s “total sales since inception amount to approximately \$294,961,048.”⁷⁹ Applicant’s “estimated annual sales are as follows: \$5,608,461 in 2014; \$15,092,712 in 2015; \$24,248,535 in 2016; \$41,609,094 in 2017; and \$50,979,325 in 2018; \$63,250,397 in 2019; \$53,704,359 in 2020; [and] Approx. \$40,468,165 until June 2021.”⁸⁰ These sales are impressive, but again, Applicant has not identified what portion of these sales is attributable to U.S. consumers.⁸¹ *See Olin Corp. v.*

⁷⁹ August 11, 2021 Office Action Response, TSDR 23, Second Chaddah Affidavit, ¶ 15.

⁸⁰ August 11, 2021 Office Action Response, TSDR 23, Second Chaddah Affidavit, ¶ 14. Mr. Jonna testified to the same “estimated annual sales” through 2018, which was prior to the January 6, 2020 date of his affidavit.

⁸¹ In its reply brief, Applicant asserts that “all sales and advertising figures are for the U.S. which makes sense since Applicant is seeking a U.S. Federal Trademark Registration.” Reply Brief, 20 TTABVUE 11. The question is not what would “make sense” (that is, if we engaged in speculation), but what the evidence shows, and it does not support Applicant’s assertion. We make no assumption that the figures are specific to the U.S., particularly as the documentary evidence supporting Applicant’s webpage views identifies the source as “All

Hydrotreat, Inc., 210 USPQ 63, 68 (TTAB 1981) (criticizing testimony of sales that “included domestic and international sales without any indication [of] what the domestic sales were”). Further, we must consider the consumer reviews discussed above suggesting that some consumers were unaware that they were making purchases through Applicant’s website, mistakenly believing they were using a particular hotel’s reservation service. Evidence that some sales were made without any brand recognition of RESERVATIONS.COM undermines the significance of Applicant’s sales figures.

There also is contradictory evidence regarding the number of “complete[d] hotel and automobile reservations” made through the “www.reservations.com branded website” from 2014 through 2018. Mr. Jonna testifies that the following reservations were made by U.S. consumers while Mr. Chaddah avers that the same number of reservations were made by U.S. **and** Canadian consumers:

- 154,270 reservations in 2014;
- 334,184 reservations in 2015;
- 597,666 reservations in 2016;
- 863,125 reservations in 2017; and
- 925,192 reservations in 2018.⁸²

Mr. Chaddah further avers that in the U.S. and Canada 1,125,666 reservations were completed in 2019; 1,056,058 were completed in 2020; and 903,266 were completed in 2021 as of June 22, 2021.⁸³

Users” and Mr. Chaddah testified that the number of reservations made through Applicant’s website include reservations from Canadian consumers.

⁸² January 6, 2020 Office Action Response, TSDR 21, Jonna Affidavit, ¶ 8; August 11, 2021 Office Action Response, TSDR 22, Second Chaddah Affidavit, ¶ 10.

⁸³ August 11, 2021 Office Action Response, TSDR 22, Second Chaddah Affidavit, ¶ 10.

The discrepancy between the Jonna and Chaddah affidavits as to whether the reservations were made by U.S. consumers or U.S. and Canadian consumers calls into question the accuracy of the cited reservation figures. Assuming the reservation numbers include both the U.S. and Canada, we do not know how much lower these figures would be if reservations made by Canadian consumers were excluded. The ambiguous nature of this evidence weakens its evidentiary value.

In addition, Applicant has not introduced evidence regarding its market share or where Applicant's services rank in the industry in terms of sales and reservations so we are unable "to accurately gauge" the level of Applicant's commercial success. *Target Brands v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007). This further reduces the probative value of Applicant's raw sales and reservations figures. *In re MK Diamond Prods.*, 2020 USPQ2d 10882, at *23 (probative value of raw sales figures were diminished due to lack of industry context); *cf. Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) ("Raw numbers of ... sales [from the rendition of services] ... in today's world may be misleading... Consequently, some context in which to place raw statistics is reasonable ... [such as] the substantiality of the sales ... for comparable [services rendered by others, or Applicant's relative] ... market share ...").

5. Factor Five: Intentional Copying

There is no evidence of third parties intentionally copying Applicant's proposed mark RESERVATIONS.COM.

6. Factor Six: Unsolicited Media Coverage of the Services Identified by the Proposed Mark

Mr. Chaddah avers that Applicant and its founders have received numerous “awards and recognitions,” namely:⁸⁴

- Entrepreneur of the Year 2020 Florida Award presented to Applicant’s co-founders Yatin Patel and Mahesh Chaddah;
- Inc. 5000 2019 List of Fastest Growing Companies in America;
- Deloitte Technology Fast 500 2019 North America;
- 2020 FINANCIAL TIMES, “Named One of Americas’ Fastest-Growing Companies”;
- 2020 INSIGHT SUCCESS MAGAZINE: Yatin Patel recognized as one of “The 10 Most Inspiring CEOs to Watch”;
- ORLANDO BUSINESS JOURNAL, “2019 Central Florida Fast 50” companies;
- 2019 ORLANDO BUSINESS JOURNAL, “Golden 100” list recognizing “the top 100 privately held companies”;
- “9th Annual Best in Biz Awards 2019” in the “business to consumer category”;
- “8th Annual Best in Biz Awards 2018” in “numerous categories”;
- American Business Awards, 2017 Stevie Bronze Award”;
- THE SILICON REVIEW, 30 Best CEOs of the Year 2020 recognizing Yatin Patel; and
- Asian American Business Development Center, recognizing “Co-Founder Yatin Patel” in 2019 “Outstanding 50 Asian Americans in Business Awards[.]”

Notably, many of these awards are from industry and financial publications, one local to Applicant’s headquarters in Orlando, Florida, as well as business groups. It

⁸⁴ August 11, 2021 Office Action Response, Second Chaddah Affidavit, TSDR 21-22, ¶ 9; *see also id.* at 97-102, Exhibit 1.

is not clear whether relevant consumers would be aware of such awards unless they were to navigate to the “awards” page on Applicant’s website. Moreover, some of the awards appear to have been given to the individual founders of Applicant as opposed to Applicant itself.

The record also includes eight articles discussing Applicant’s services.⁸⁵ This is not a significant amount of unsolicited media coverage given that Applicant has been using RESERVATIONS.COM since 2014. The record also does not include any information regarding the circulation of these publications or article impressions, further reducing the weight of this evidence.

7. Other Relevant Evidence

The testimony of Mr. Jonna and Mr. Chaddah regarding their understanding of consumer perception is also potentially pertinent, though unsurprisingly self-serving.

Mr. Jonna avers that:

- “As a result of [Applicant’s] continuous use, extensive sales, significant advertising and promotional activities under the RESERVATIONS.COM mark, the mark has become recognized by the public and the trade as identifying [Applicant’s] services. [Applicant] has substantial goodwill vested in this mark and the RESERVATIONS.COM service mark identifies [Applicant] as the source of the services promoted and provided under the RESERVATIONS.COM service mark.”⁸⁶

Similarly, Mr. Chaddah avers that:⁸⁷

⁸⁵ One of the eight articles is from a foreign publication. We give this article some consideration to the extent it is in English and might be accessed by some U.S. consumers. One additional article is identified as a press release and, therefore, does not constitute “unsolicited” media coverage as is pertinent under this factor.

⁸⁶ January 6, 2020 Office Action Response, TSDR 21, Jonna Affidavit, ¶ 6.

⁸⁷ August 11, 2021 Office Action Response, TSDR 22-23, Second Chaddah Affidavit, ¶¶ 7, 17.

- “As a result of [Applicant’s] continuous use, extensive sales, significant advertising and promotional activities under the RESERVATIONS.COM mark, the mark has become recognized by the public and the trade as identifying [Applicant’s] services. [Applicant] has substantial goodwill vested in this mark and the RESERVATIONS.COM service mark identifies [Applicant] as the source of the services promoted and provided under the RESERVATIONS.COM service mark.”
- “I personally, as an Officer of [Applicant] and through my work and travel have come into contact with thousands of clients and potential clients throughout the United States promoting my company’s services under the RESERVATIONS.COM mark, and it is my impression from such consumers that they are aware that RESERVATIONS.COM services originate from my company rather than merely describing the services.”

The Examining Attorney criticizes declarations and affidavits, like the ones here, from “an applicant’s employees, officers, and attorneys” as “usually self-serving and entitled to little weight.”⁸⁸ This is a valid criticism. *Cent. Cntys. Bank*, 209 USPQ at 888 (self-serving statements of an applicant’s officers entitled to little, if any, probative value on the question of registrability). The declarations are also conclusory and, as discussed above, the averments are based on contradictory and over-inclusive factual statements regarding sales, advertising, page views and reservations, and therefore, carry less weight. *Mars Generation*, 2021 USPQ2d 1057, at *19-20 (finding unpersuasive “conclusory” testimony “lacking in accuracy”); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1481 (TTAB 2017) (rejecting “conclusory” testimony “unsupported by available data”). Further, we do not rely on the legal conclusions of witnesses as we must reach our own legal conclusions based on the evidence of record before us. *Alcatraz Media, v. Chesapeake Marine Tours*, 107

⁸⁸ Appeal Brief, 19 TTABVUE 13.

USPQ2d at 1755, 1757; *cf. Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (likelihood of confusion is a legal conclusion; “under no circumstances, may a party’s opinion ... relieve the decision maker of the burden of reaching [its] own ultimate conclusion on the entire record”); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (Board will not substitute witness opinion for evaluation of facts in a case under Section 2(d) of the Trademark Act).

C. Conclusion Regarding Acquired Distinctiveness

Applicant’s proposed mark is highly descriptive of Applicant’s services and the record does not support Applicant’s assertion that its use of RESERVATIONS.COM has been “substantially exclusive.” Under these circumstances, Applicant’s use of RESERVATIONS.COM since 2014 is far from sufficient to demonstrate acquired distinctiveness. The survey evidence and consumer reviews do not support a finding that the proposed mark has acquired distinctiveness as a source identifier. In addition, Applicant’s figures regarding advertising, sales, reservations, and webpage views do not appear to be limited to the U.S., and we are lacking important information regarding Applicant’s U.S. market share and U.S. consumer exposure to Applicant’s advertising as well as examples of how the proposed mark is used in advertising, on the Bing and Yahoo search engines in particular.

Weighing all of the evidence of record, we find that Applicant has failed to demonstrate that the highly descriptive term RESERVATIONS.COM has acquired distinctiveness among relevant U.S. consumers as a source identifier for Applicant’s services.

IV. Decision

The refusal to register the proposed mark under Section 23(c) of the Trademark Act on the ground that RESERVATIONS.COM is generic for Applicant's services is **reversed**. The refusal to register Applicant's proposed mark on the Principal Register on the ground that it is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and has not acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f) is **affirmed**.

Applicant's proposed mark will proceed on the Supplemental Register.